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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,642	02/21/2002	Norbert Hofgen	HUBR-1203.2Cont	4195

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,642

Applicant(s)

HOFGEN ET AL.

Examiner

Patricia L. Morris

Art Unit

1625

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 25, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 26 and 28-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 21, 26 and 28-36 are under consideration in this application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2005 has been entered.

Election/Restrictions

The restriction requirement is deemed sound and proper and is hereby maintained. Claims 21, 26 and 28-36 have been examined to the extent readable on the elected subject matter. It is suggested that the nonelected subject matter be deleted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1625

Claims 21, 26 and 28-36 are rejected under 35 U.S.C. 102(a) and/or (b) as being anticipated by Rehse et al., Friderichs et al., Allen et al., Itoh et al., Liu et al., von Angerer et al. I, II and Matsuoka et al. for the reasons set forth in the record.

Again, the references disclose the instant process. Note, for example, scheme 2 on page 5900 of Itoh et al. or scheme 7 of Liu et al. or scheme 1 of von Angerer et al. I. Hence, the instant process is deemed to be anticipated by the references.

Contra to applicants' arguments in the instant response, applicants are claiming a process, not compounds.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1625

Claims 21, 26 and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Rehse et al., Friderichs et al., Allen et al., Itoh et al., Liu et al., von Angerer et al. I, II and Matsuoka et al. for the reason set forth in the record.

Again, the references disclose the instant process. Note, for example, scheme 2 of Itoh et al. or scheme 7 of Liu et al. As here, an methoxy is demethylated to obtain an hydroxy group. The reaction of a specific methoxy group with a demethylating agent does not render the process step itself patentable, anew; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill.

Again, a long line of cases had that the mere use of a different starting material, whether novel or known, in a conventional process to produce the product one would expect therefrom does not render the process unobvious. In re Surrey et al. (CCPA 1963) 319 F2d 233, 138 USPQ 67; In re Kanter (CCPA 1968) 399 F2d 249, 158 USPQ 331; In re Larsen (CCPA 1961) 292 F2d 531, 130 USPQ 209; In re Albertson (CCPA 1964) 332 F2d 379, 141 USPQ 730; Ex parte Ryland et al. (POBA 1948) 108 USPQ 15; In re Kerkhoven (CCPA 1980) 626 F2d 846, 205 USPQ 1069.

Applicants are claiming a process not compounds. Applicants appear to couch their arguments with respect to the patentability of the compounds. These are process claims. In a

Art Unit: 1625

Graham vs John Deere analysis of a process, variation in the non-reactive portion of the molecule is not an essential variation, as it does not enter into the process itself. In the instant case, the reactive sites are the same and it is expected that the methoxy group will be demethylated to obtain an hydroxy group. The substitution in the non-reactive portion of the molecule makes no difference. So, there are no substantive differences to point out. The instant reaction occurs as predicted by the prior art. Chemists plan their reactions. They know ahead of time what is going to happen to the methoxy group when reacted with a demethylating agent. They, therefore, know ahead of time how to introduce an hydroxy group. Chemists most often produce products by known means.

Again, applicants have failed to show any objective evidence establishing any unobvious properties for the claimed process *vis-à-vis* the prior art processes. No unexpected or unobvious properties are noted.

In re Ochiai does **not** apply herein because the instant compounds are well known in the art. The compounds are not novel as incorrectly alleged by applicants. Applicants are invited to note the Office action mailed November 15, 2002 wherein the compounds are shown to be known in the prior art. Applicants are claiming **a process, not compounds**.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1625

Claims 21 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Again, the claims fail to recite a complete process. The term converting fails to describe the process. How is the compound of formula (I) converted into a compound of formula (I)? No where in claims 21 and 28 are R^2 or R^3 or R^2 and R^3 are defined as OR⁷? The variables R^2 and R^3 can only be hydrogen or hydroxyl. Demethylation ester cleavage are obvious processes under 35 USC 103. Claims 21 and 28 fail to recite the reaction conditions, *i.e.*, reactants, reagents, temperature, solvents, etc.

Applicants assert that the claims define the process. How is R^7 removed and with one reagent? How are the esters cleaved? How is suitability determined? What is meant by suitable? The claims are clearly readable on the prior art.

Contra to applicants' arguments in the instant response, one cannot tell from a simple reading of the claim what is being claimed. One must first conceive of the alleged process. Then one must, by preparing the compound himself, determine if the process works or not. Where is the specific claiming and distinctly pointing out? How can applicants regard as their invention inexact concepts? The breadth of which they could not have possibly checked out with representative exemplification.

Applicants are claiming a process of producing a compound of the formula. Pure chemistry, a compound. Not a resin of general property ranges, but a pure compound. That process is used for any purpose is taken from the public in a 20-year monopoly to applicants. Then, the public is entitled to know what process they cannot use. Yet, the claim is not specific

Art Unit: 1625

to that process. The public cannot tell what process they may not use. How is a claim of the instant breadth defensible in an infringement action?

Conclusion

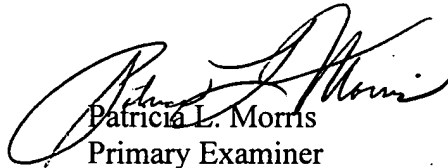
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688.

The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L. Morris
Primary Examiner
Art Unit 1625

plm

September 19, 2005